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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/912,352 | 07/26/2001 | Lawrence A. Denenberg | 782.1100 | 5411 |

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EXAMINER

GAUTHIER, GERALD

ART UNIT PAPER NUMBER

2645

DATE MAILED: 03/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/912,352

Applicant(s)

DENENBERG ET AL.

Examiner

Gerald Gauthier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-63 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-63 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>8/24/2001</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on August 24, 2001 was received. The submission is in compliance with the provisions of 37 CFR 1.97.

Accordingly, the examiner is considering the information disclosure statement.

Claim(s) Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claim(s) 1-63** are rejected under 35 U.S.C. 102(b) as being anticipated by Hazenfield (US 5,991,374).

Regarding **claim(s) 1, 48 and 52**, Hazenfield discloses a messaging system (column 1, lines 9-13), wherein:

each of a plurality of messages is associated with at least two attributes (FIG. 16 and column 10, lines 42-47) [The playlist comprises a list of messages represented in three tables]; and

the plurality of messages is categorized according to the at least two attributes into overlapping lists of messages (FIG. 16, 17 and 18 and column 10, lines 47-61) [The

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sequence field in the playlist message table 106 and the playlist site table 108 comprises a command sequence identification code].

Regarding **claim(s) 2, 7, 14, 19, 53 and 58**, Hazenfield discloses the at least two attributes comprise an urgency indicator and a message received date (column 10, lines 47-61).

Regarding **claim(s) 3, 8, 15, 20, 54 and 59**, Hazenfield discloses the at least two attributes further comprise a message medium indicator (column 10, lines 25-41).

Regarding **claim(s) 4, 9, 16, 21, 55 and 60**, Hazenfield discloses the at least two attributes further comprise a message sender identity indicator (column 10, lines 25-41).

Regarding **claim(s) 5, 10-11, 17, 22-23, 56 and 61-62**, Hazenfield discloses each of the plurality of messages is associated with a status that can represent one of at least three distinct statuses (column 10, lines 42-61).

Regarding **claim(s) 6, 12, 18, 24, 57 and 63**, Hazenfield discloses the at least three distinct statuses comprise "new" "old" and "read" (column 14, lines 18-31).

Regarding **claim(s) 13**, Hazenfield discloses all the limitations of **claim(s) 13** as stated in **claim(s) 1**'s rejection above and furthermore Hazenfield discloses a memory

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storing a plurality of messages, each message being associated with at least two attributes (FIG. 4 and column 10, lines 42-47) [The server 12 comprises a list of messages and a list of destinations].

Regarding **claim(s) 25**, Hazenfield discloses the system can select a list of messages for presentation comprising an intersection of at least two of the overlapping lists (column 10, lines 42-47).

Regarding **claim(s) 26 and 29**, Hazenfield discloses the system selects the list of messages for presentation in response to a user input (column 10, lines 25-41).

Regarding **claim(s) 27**, Hazenfield discloses the system can select a list of messages for presentation comprising an intersection of at least two of the overlapping lists (column 10, lines 25-41).

Regarding **claim(s) 28**, Hazenfield discloses the intersection is a logical AND or logical OR of the at least two of the overlapping lists (column 10, lines 47-61).

Regarding **claim(s) 30 and 49**, Hazenfield discloses a method of processing a newly-arrived message (column 1, lines 9-13), comprising;

receiving the newly-arrived message during a session (FIG. 35 and column 17, lines 3-14) [The SSTATE field changes from to new for a new receiving message]; and

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presenting the newly-arrived message to a user before the user takes action to end the session (FIG. 35 and column 17, lines 47-63) [The server 12 generate a request message to notify the a client of changes made to playlist while the user is in session].

Regarding **claim(s) 31**, Hazenfield discloses the newly-arrived message is presented only if the newly-arrived message is urgent (column 10, lines 47-61).

Regarding **claim(s) 32 and 37**, Hazenfield discloses interrupting presentation of a message to present the newly-arrived message (column 17, lines 47-63).

Regarding **claim(s) 33 and 35**, Hazenfield discloses the interrupting occurs only if the newly-arrived message is urgent (column 10, lines 47-61).

Regarding **claim(s) 34, 38 and 51**, Hazenfield discloses presenting the newly-arrived message before presenting any other message (column 10, lines 42-47).

Regarding **claim(s) 36**, Hazenfield discloses ascertaining, in accordance with:
a command issued by the user during the session, but prior to the receiving the newly-arrived message, and attributes of the newly-arrived message, whether the system would have presented the newly-arrived message earlier in the session if the newly-arrived message had arrived earlier in the session (column 17, lines 15-35).

Regarding **claim(s) 39**, Hazenfield discloses if the newly-arrived message would not have been presented earlier in the session, including the newly-arrived message in a currently-selected set of message to present to the User (column 17, lines 15-35).

Regarding **claim(s) 40 and 50**, Hazenfield discloses the newly-arrived message is presented before the user changes message selection criteria (column 17, lines 15-35).

Regarding **claim(s) 41**, Hazenfield discloses adding the newly-arrived message to a set of messages that are currently selected for presentation (column 17, lines 15-35).

Regarding **claim(s) 42**, Hazenfield discloses all the limitations of **claim(s) 42** in the **claim(s) 30**'s rejection above and furthermore Hazenfield discloses responsive to a user command issued during a session, selecting a set of messages to present to the user (FIG. 41-52 and column 18, lines 3-25) [The server 12 receives command of the user for a selection of message to be played].

Regarding **claim(s) 43**, Hazenfield discloses the newly-arrived message is included in the set of messages to present to the user only if attributes of the newly-arrived message satisfy all selection criteria associated with the user command (column 17, lines 15-36).

Regarding **claim(s) 44 and 46**, Hazenfield discloses at least one of the at least two attributes corresponds to at least one non-user-defined field in an address book (column 10, lines 47-61).

Regarding **claim(s) 45 and 47**, Hazenfield discloses at least one of the at least two attributes corresponds to at least one user-defined field in an address book (column 10, lines 47-61).

Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald Gauthier whose telephone number is (703) 305-0981. The examiner can normally be reached on 8:00 AM to 4:30 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (703) 305-4895. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

GERALD GAUTHIER
PATENT EXAMINER

g.g.
March 15, 2005


FAN TSANG
SUPERVISOR PATENT EXAMINER
ER 2600